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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,938	06/27/2001	Raouf Botros	SDP273PA	6293

1333 7590 07/15/2004

PATENT LEGAL STAFF
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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,938

Applicant(s)

BOTROS ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-14,17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 4/28/04.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 9-14, 17-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (U.S. 5,958,999) in view of Moffatt et al. (U.S. 6,323,257).

The rejection is adequately set forth in paragraph 4 of the office action mailed 12/23/04 and is incorporated here by reference.

4. Claims 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. in view of Moffatt et al. as applied to claims 1, 9-14, 17-18, and 20 above, and further in view of Kashiwazaki et al. (U.S. 6,011,098).

The rejection is adequately set forth in paragraph 5 of the office action mailed 12/23/04 and is incorporated here by reference.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. in view of Moffatt et al. as applied to claims 1, 9-14, 17-18, and 20 above, and further in view of Hayes (U.S. 4,150,997).

The rejection is adequately set forth in paragraph 6 of the office action mailed 12/23/04 and is incorporated here by reference.

Response to Arguments

6. Applicants' arguments regarding Gundlach et al. (U.S. 6,258,873) have been fully considered but they are moot in view of the discontinuation of the use of this reference against the present claims.

7. Applicants' arguments filed 4/28/04 have been fully considered but, with the exception of arguments relating to Gundlach et al., they are not persuasive.

Specifically, applicants argue that all the cited prior art relates to ink jet ink compositions whereas the subject application relates to coating material for substrate treatments.

It is agreed that all the cited prior art is drawn to ink jet inks. However, it is noted that the present claims are broadly drawn to coating composition that clearly encompasses inks given that are used to print on, or coat, substrate such as paper.

While there is no disclosure that the compositions of the prior art are "for application on an ink jet printed porous substrate for improving the waterfastness of the ink jet image" as recited in claim 1, this recitation is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Bates et al. in combination with Moffatt et al. disclose composition comprising the same types and amounts of ingredients as presently claimed, it is clear that the composition would be capable of performing the intended use, i.e. "for application on an ink jet printed porous substrate for improving the waterfastness of the ink jet image", presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

Applicants further argue that the problems solved by the prior art do not relate to the coating composition of the subject invention and the differences between the prior art and the claims are too numerous to be able to use the cited art to obviate the subject invention.

While it is agreed that the cited prior art solves different problem than that of the present invention, it is noted that given that the present claims are drawn to coating composition and given that the combination of Bates et al. and Gundlach et al. (used further in view of Kashiwazaki et al. and Hayes) disclose composition comprising ethoxylated polyethyleneimine, pH modifier, guar gum,, electrolyte, surfactant, and water as presently claimed, it is clear that the prior art meets all the limitations of the present claims. Further, given that the composition of the prior art discloses composition comprising same types and amounts of ingredients as presently claimed, it is clear that such composition would intrinsically possess the same waterfastness, smudge resistance, and bleed resistance as the composition of the instant invention. While applicants argue that the differences between the prior art and the claims are too numerous to be

able to use the prior art against the present claims, applicants offer no evidence to support their position. Further, given that the prior art meets all the requirements of the present claims, it is the examiner's position that the prior art of record remains relevant against the present claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

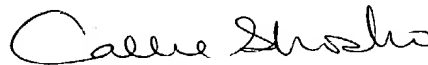
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
7/2/04